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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,412	06/13/2006	Jae Keol Rhee	TRIUS.002NP	6355

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EXAMINER	
MORRIS, PATRICIA L	

ART UNIT	PAPER NUMBER
1625	

NOTIFICATION DATE	DELIVERY MODE
02/11/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No.	Applicant(s)	
	10/596,412	RHEE ET AL.	
	Examiner	Art Unit	
	Patricia L. Morris	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 2008*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 16-50* is/are pending in the application.

4a) Of the above claim(s) *1-13,16, 23-35 and 47-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-22 and 36-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The previous office action mailed 29 January 2009 is hereby vacated. A new action on the merits follows.

Election/Restrictions

Claims 1-13 and 16-50 are pending in this application. On consideration, the restriction requirement among groups XII-XIV set forth in the office action of 6 March 2008 is withdrawn. Claims 17-22 and 36-46 are rejoined and are under examination in this office action. Claims 1-13, 16, 23-35, and 47-50 remain withdrawn from consideration as being drawn to non-elected subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-22 and 36-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (US 7,129,259).

Chen et al the instant iodination process. Note example 1, column 59, lines 33-54 of Chen et al., therein. Hence, the process is deemed to be anticipated therefrom.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17-22 and 36-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Lee et al. (US 6,689,779), Chen et al.,Fukuda I (US 2005/0038092), II (US 2007/0185132) and Barbachyn et al. I (US 5,523,403), II (US 5,565,571).

Lee et al., Chen et al., Fukuda I, II and Barbachyn et al. I, II disclose the instant processes. Lee et al. generically embrace the claimed process. Note scheme 4 wherein position 4 of the phenyl is displaced with trimethyl stannyl by reaction with hexamethylditin in the presence of a palladium catalyst whereas, Chen et al. teach an iodination reaction using N-iodosuccinimide and the reaction of the compound of formula (V) with an amino acid. Note scheme 1, lines 35-45, in column 57 and columns 111-112 therein. Fukuda I, II and Barbachyn et al. I, II teach halogenation using iodine monochloride in acetic acid or acetic acid/ trifluoroacetic acid or with iodine and silver trifluoroacetate or with iodine and silver

trifluoroacetate or the compound can be brominated using N-bromosuccinimide. Note column 10, lines 39-49 in column 10 or preparation 18 or last reaction in columns 29-30 of Barbachyn et al. II or reference example 49 of Fukuda I or reference example 22 of Fukuda II. The prior art processes of Lee et al., Fukuda et al. II and Barbachyn et al. I, II differ only in the starting material. However, Chen et al. recites that the instant alcohol of formula (II) may be used. As here, a phenyl ring is halogenated in the same position by a bromine or iodine halogenating agent and then reacted with trimethyl stannyl. The reaction of a specific phenyl compound with a halogenating agent ot tin reagent does not render the process step itself patentable, anew; In re Albertson, 141 USPQ 730, which was specifically reaffirmed on the last page of In re Kuehl, 177 USPQ 250.

One having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product, because he would have expected the analogous starting materials to react similarly. It has been held that application of an old process to a new and analogous material to obtain a result consistent with the teachings of the art would have been obvious to one having ordinary skill.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patricia L. Morris/
Primary Examiner, Art Unit 1625

plm
February 4, 2009